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Paper 9

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In re Application of  
Akashi, et al.  
Application No. 08/918,537  
Filed: 22 August, 1997  
Attorney Docket No. STAN-064

OFFICE OF PETITIONS  
A/C PATENTS  
ON PETITION

This is a decision on the petitions to revive the above-identified applications filed, 30 November, 2000, under 37 C.F.R. §1.137,<sup>1</sup> subsection (a), and supplemented on 22 March, 2001, under 37 C.F.R. §1.137, subsection (b).

The petition under 37 C.F.R. §1.137(b) is **GRANTED**, and pursuant to Petitioner's request, the petition under 37 C.F.R. §1.137(a) is **withdrawn and not considered**.<sup>2</sup>

<sup>1</sup> The regulations at 37 C.F.R. §1.137 provide:

**§1.137 Revival of abandoned application or lapsed patent.**

(a) *Unavoidable*. Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in §1.17(l);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (c) of this section.

(b) *Unintentional*. Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in §1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (c) of this section.

(c) In a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995, any petition to revive pursuant to this section must be accompanied by a terminal disclaimer and fee as set forth in §1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application. Any terminal disclaimer pursuant to this paragraph must also apply to any patent granted on any continuing application that contains a specific reference under 35 U.S.C. §§120, 121, or 365(c) to the application for which revival is sought. The provisions of this paragraph do not apply to lapsed patents.

(d) Any request for reconsideration or review of a decision refusing to revive an abandoned application or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of §1.136.

(e) A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section so as to be pending for a period of no longer than twelve months from its filing date. Under no circumstances will a provisional application be regarded as pending after twelve months from its filing date.

[47 Fed. Reg. 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 Fed. Reg. 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras. (a) - (c), paras. (d) & (e) added, 58 Fed. Reg. 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (c) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997].

<sup>2</sup> In the petition alleging unintentional delay filed on 22 March, 2001, Petitioner requested that the Office "substitute" that filing for the November petition alleging unavoidable delay, and the Office is interpreting that request as a withdrawal of the November petition.

The record reflects that:

- Petitioner failed to respond timely and properly to a Notice to File Missing Parts (Filing Date Granted) mailed on 2 December, 1997, and due (absent extension of time) on or before 2 February, 1998;
- Petitioner acknowledges that the unsigned oath/declaration submitted upon filing contained the incorrect correspondence address submitted by and for Petitioner;
- the Notice to File Missing Parts was mailed to the address so designated (in error) by Petitioner;
- the instant application went abandoned at midnight 10 August, 2000;
- Notice of Abandonment was mailed on 16 November, 2000, to the address so designated (in error) by Petitioner;
- on 30 November, 2000, Petitioner filed a Petition to Revive under 37 C.F.R. §1.137(a)<sup>3</sup> and a reply to the Notice of Missing Parts;
- on 22 March, 2001, Petitioner filed the petition under 37 C.F.R. §1.137(b);<sup>4</sup>
- the copy of the Notice of Change of Address, submitted on 30 November, 2000, but dated 29 March 2000, and not otherwise present in the record, has been accepted as Petitioner's Notice of Change of Address, and Office records updated to reflect that change.

The record (including the petitions filed on 30 November, 2000, and 22 March, 2001) does not necessitate a finding that the delay between midnight 2 February, 1998, and 22 March, 2001, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioner's duty of candor and good faith when accepting Petitioner's representation that the delay in filing the response was unintentional.<sup>5</sup>

This application is being forwarded to OIPE for further processing.

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<sup>3</sup> An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

<sup>4</sup> Pursuant to Petitioner's authorization, the \$55.00 fee for the petition under 37 C.F.R. §1.137(a) is credited and the \$620.00 fee for the petition under 37 C.F.R. §1.137(b) charged to Deposit Account 50-0815.

<sup>5</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

Telephone inquiries should be directed to Petitions Attorney John J. Gillon, Jr., at (703) 305-9199.

A handwritten signature in black ink, appearing to be 'J. Gillon, Jr.', with a long horizontal stroke extending to the right.

John J. Gillon, Jr.  
Attorney  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy